



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/092,049

03/04/2002

Robert C. Chang

SANDP015

7791

10027

7590

08/30/2006

ANDERSON, LEVINE & LINTEL L.L.P.
14785 PRESTON ROAD
SUITE 650
DALLAS, TX 75254

EXAMINER

LEMMA, SAMSON B

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/092,049	Applicant(s) CHANG ET AL.	
	Examiner Samson B. Lemma	Art Unit 2132	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,5-8,11-13 and 17-24.

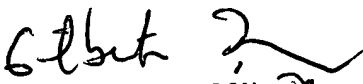
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 11. does NOT place the application in condition for allowance because: Examiner asserts that arguments/remarks that have been filed on August 17, 2006 have been fully considered but they are not persuasive. Regarding the independent claims 1 and 13, applicant argued that examiner interpretation of flash memory device of claim to the memory array of 150 of the Jones et al reference and the claim limitation recited as reader in the claim to that of the smartcard integrated circuit 250 of the reference is incorrect. Applicants argued that element 250 of the Jones et al, reference on the record,

cannot correspond to the reader of claim 1 and its dependent claims.

Examiner disagrees with the argument.

Examiner would point out that, Jones et al, the reference on the record, discloses the

following.

"The smartcard integrated circuit 250 advantageously stores such passwords, public key and secret key values, and/or digital signatures in an Electrically Erasable Programmable Read Only Memory (EEPROM), and further includes its own microprocessor containing a stored program to allow reading and writing of the EEPROM through a serial I/O interface." [See, column 2, lines 44-50]

Applicant further argued that element 150 of the Jones et al, reference on the record, cannot correspond to the flash memory device of the claim.

Examiner disagrees with the above argument too.

Examiner would point out that, Jones et al, the reference on the record, discloses the

following.

"The secure memory card 100 stores data in a common memory array 150, preferably implemented with non-volatile flash memory integrated circuits, enabling the common memory array to store 10 megabytes of data in an area small enough to be included on a credit-card sized Type I PCMCIA card." [See, column 3, lines 50-55]

Furthermore Jones et al on column 6 lines 14-17 discloses the following.

"This additional encryption mechanism protects data stored in the common memory array even if that data is successfully read from the flash memory chips making up the array 150."

The other argument presented by the applicant is that Jones et al the reference on the record does not disclose the limitation "inserting the flash memory storage device into the reader."

Examiner agreed with this particular applicant's argument. In other words Applicant argument is not only persuasive but also correct that this limitation is not taught/disclosed in John's reference. However Examiner used a secondary reference namely the Tatebayahi et al to make up the shortfall of the Jones's /primary reference.

As applicant has agreed with the examiner, the secondary reference namely Tatebayachi discloses the limitation "inserting the flash memory storage device into the reader" and make up for the shortfall of the Jones et al reference in this regard.

For instance Tatebayashi discloses

Inserting the flash memory storage device into the reader. [Column 18, lines 9-29; figure 8, figure 2, figure 6 and figure 18]

Furthermore As shown on figure 6 the reader stores a key and as indicated on the abstract, the reader using the key decrypts an encrypted content stored in the flash memory 200]

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the feature of inserting the flash memory storage device into the reader as per teachings of Tatebayashi in to the method as taught by Jones, in order to authenticate the flash memory with the reader.[See Tatebayashi, column 18, lines 10-12]

It is important to note that the Applicant cannot show non-obviousness by attacking references individually where as here the rejection is based on the combination of the reference. In re Keller, 208 USPQ (CCPA 1981)

Therefore the combination of Jones et al and Tatebayahi et al discloses each and every limitations of the claim. The rejection is maintained until the applicant further amends at least the independent claims and overcome the rejection. Though, the application could contain allowable subject matter, the independent claims have not yet been written to reflect the invention.

Finally applicant argument presented to the dependent claims is not persuasive since the dependent claims stands and falls with the corresponding independent claims.